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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,263	12/22/2003	Ulrich Sieben	Micronas.7865	4471

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EXAMINER
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RAMILLANO, LORE JANET

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/743,263	<b>Applicant(s)</b> SIEBEN, ULRICH	
	<b>Examiner</b> Lore Ramillano	<b>Art Unit</b> 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 12-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                            |                                                                                        |
|--------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/15/05</u> | 6) <input type="checkbox"/> Other: ____                                                |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. **Claims 1-11, 45, and 46**, drawn to a carrier medium for analyzing an analyte, classified in class 436, subclass 164.
- II. **Claims 12-18 and 36-40**, drawn to a method for manufacturing a carrier media, classified in class 436, subclass 809.
- III. **Claims 19-23 and 41**, drawn to a device for reading a carrier medium, classified in class 382, subclass 133.
- IV. **Claims 24-35 and 42-44**, drawn to a method for reading a carrier medium, classified in class 702, subclass 19.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make another and materially different product, such as a bioarray device.

Inventions of Groups III and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they

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have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not capable of use together and they have different designs, modes of operation, and effects because the invention of Group III comprises an optical detector, which enables it to perform optical analyses, whereas, the invention of Group I lacks this optical detector element, which prevents it from performing similar types of optical analyses.

Inventions of Groups I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the product as claimed can be used in a materially different process of using that product, such as analyzing a substance on a test strip.

Inventions of Groups II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as performing an optical spectrographic analysis.

Inventions of Groups II and IV are directed to related processes. The related inventions are distinct if the inventions as claimed do not overlap in

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scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, the inventions of Groups II and IV do not overlap because the invention of Group II involves the process of making, whereas, the invention of Group IV involves the process of using. In addition, the inventions as claimed do not have obvious variants because the invention of Group II comprises a specific type of arrangements and the invention of Group IV comprises a specific type of administrative center elements. Furthermore, the inventions as claimed can have a materially different design, mode of operation, function, or effect because the invention of Group II lacks the administrative center element as claimed in the invention of Group IV, and the invention of Group IV lacks the administrative center elements.

Inventions of Groups IV and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as performing an optical spectrographic analysis.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their

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recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Richard H. Kosakowski on 2/21/06 a provisional election was made with traverse to prosecute the invention of **Group I, claims 1-11, 45, and 46**. Affirmation of this election must be made by applicant in replying to this Office action. **Claims 12-44** are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

3. The drawing of **Fig. 4** is objected to because the drawing is missing a reference numeral. Reference numerals, 50 and 30, are clearly indicated in the drawing, but the third reference numeral is missing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted

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after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 6, 45, and 46** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 6** recites the limitation "**the** arrangement of the defined regions" in the carrier medium. There is insufficient antecedent basis for this limitation in the claim.

**Claim 46** is indefinite because it is unclear as to whether the preamble of the claim ends after the term, "the carrier medium comprising," which is the first line of the claim.

### ***Claim Interpretation***

As to **claims 1, 7, and 45**, which contain intended use terms, the Examiner will interpret these claims in light of the structural elements that are disclosed and not for their intended use as stated after the term "for." It has been

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held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The Examiner has applied references, which are capable of meeting these functions. A structure, which is capable of providing the intended use, is considered to meet the limitation of intended use recited in a claim to a device or an apparatus.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1, 2, 6-11, 45, and 46** are rejected under **35 U.S.C. 102(b)** as being anticipated by Zeleny et al. (US 6215894).

Zeleny et al. disclose a microarray biochip ("glass carrier medium," 10, Fig. 1), which comprise two array regions ("at least two defined regions," 12 and



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14, Fig. 1). Each of the defined regions performs different experiments because each defined region comprises a different combination of reagents ("at least one substance," column 3, line 2-7), which include biological samples (ie. DNA, column 1, lines 49-52).

Zeleny et al. further disclose identifiers ("codes," 16 and 18, Fig. 1), which comprise a numeral (16a, 18a, Fig. 1) and a corresponding bar code (16b, 17b, Fig. 1). These codes provide information about the experimental parameters of each defined region, the source of each defined region, the scanning and analysis protocols, the operating parameters for the analysis protocols, and the identification of each defined region (column 3, lines 8-18).

8. **Claims 1-11, 45, and 46** are rejected under **35 U.S.C. 102(e)** as being anticipated by Woods (US 2003/0177380).

Woods discloses a device comprising an array holder (2, Fig. 1A), which includes one or more measuring sensors, such as a temperature sensor (4, Fig. 1A), and a data storage element ("code," 8, Fig. 1A). The array holder communicates with an array assay device, such as a biopolymeric array ("carrier medium," 110, Figs. 3-5), via a communication element (10, Fig. 1A).

The carrier medium is composed of a film strip, glass carrier, or paper (paragraphs [0071]-[0072]) and comprises of more than one array ("at least two defined regions, 112, Figs. 3-4), which are disposed differently because each one has distinguishable features (ie. distinct polymeric sequences, distinct sizes, and distinct configurations) (paragraphs [0067] and [0074]). Moreover, each defined region of a carrier medium will be disposed differently on another carrier

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medium because each carrier medium comprises distinguishable substances, which include biological and chemical substances (ie. DNA, paragraph [0068]). (paragraphs [0074] and [0075]).

Woods further discloses a code, which provide scanning procedures, information about the expiration date of the carrier medium, information relating to the storage of the carrier information, reagent data, temperature data, and other useful information about the carrier medium (paragraphs [0022]-[0025], and [0080]).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lore Ramillano whose telephone number is (571) 272-7420. The examiner can normally be reached on Mon. to Fri. 8:30a to 5:00p.

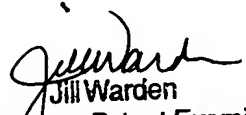
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lore Ramillano  
Examiner  
Art Unit 1743

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